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09/550,752

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Tomas Leon

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EXAMINER

HAMILTON, LALITA M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/550,752
Filing Date: April 17, 2000
Appellant(s): LEON ET AL.

S. Scott Gordon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 1, 2010 appealing from the Office action mailed October 26, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Reexam serial numbers 90/005,841 and 90,005, 842 decided May 26, 2006, the Appeal serial numbers which are 2005-2642 and 2005-2643. The Board decisions were appealed to the Federal Circuit as Federal Circuit numbers are 2006-1599 and 2006-1600. The Federal Circuit consolidated these appeals and issued a decision that is reported at 498 F.3d 1290 (Fed.Cir.2007).

This case was first decided by the BPAI on June 4, 2009, appeal number 2009-001227. Claims 42, 44, and 45 were affirmed. The Examiner was reversed on the other rejections. New grounds rejection under section 101 for reciting patent ineligible subject matter for claims 34-45 was entered by the Board.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 34-41 and 46-61

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No prior art evidence is relied upon by the examiner in the rejection of the claims under appeal.

The only evidence relied upon is stated below in the grounds of rejection under 35 U.S.C. 101 and 112 second paragraph.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 46-53 are rejected for the following reasons:

Claims 46 and 50 recite a data processor, but the body of the claim recites only method steps. It is unclear if the claim is directed to a method or an apparatus. The Appellant cannot claim the data processor with limitations directed solely to a method or process steps. For purposes of examination, the Examiner will assume the claim is directed to an apparatus. Correction is required.

The remaining claims are rejected for their dependency.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34-41 and 46-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claims 34-41, the Board entered new grounds of rejection under 35 U.S.C. 101. However, the amendments to the claims do not overcome the rejection. Claims 34-41 are still directed to an electronic financial instrument. The electronic instrument, even though stored in a data storage device, is still directed to non-statutory subject matter. Therefore, the 101 rejection shall be maintained.

Claims 46-53 are directed to a data processor (see analysis for 112(2) above); however, there are no structural elements cited in the body of claim. The claims comprise a series of steps without any recitation(s) to structural components.

Claims 54-61 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

(10) Response to Argument

The Appellant argues that Claims 46-53 are not indefinite under 35 U.S.C 112, second paragraph and that the claims are clearly directed to an apparatus. In response, the Appellant has no hardware limitations in the body of the claim. The only

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hardware is data processor in the preamble. There is only method steps listed in the apparatus claim. Therefore, the Examiner is maintaining the grounds of rejection under 35 U.S.C. 112, second paragraph.

The Appellant argues that claims 34-41 and 46-61 are directed to statutory subject matter. In response, the Board issued entered new grounds of rejection under 35 U.S.C. 101. The amendments to the claims did not overcome the rejection. Claims 34-41 are still directed to an electronic financial instrument. The electronic instrument, even though stored in a data storage device, is still directed to non-statutory subject matter. Therefore, the 101 shall be maintained.

Claims 46-53 are directed to a data processor (see analysis for 112(2) above); however, there are no structural elements cited in the body of claim. The claims comprise a series of steps without any recitation(s) to structural components.

Claims 54-61 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

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Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

(11) Related Proceeding(s) Appendix

Respectfully submitted,

/Lalita M Hamilton/

Vincent Millin/vm/
Appeals Conference Specialist

Conferees:

Alexander Kalinowski/AK/

Supervisory Patent Examiner, Art Unit 3691